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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,989	11/18/2003	Stephane Bedard	TJK/432	4888
27717 7590 10/25/2007 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE2400 CHICAGO, IL 60603-5803			EXAMINER MATTHEWS, WILLIAM H	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/715,989

Applicant(s)

BEDARD ET AL.

Examiner

William H. Matthews (Howie)

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-37 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7,8,10-15,20 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,16-19,21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 8-13-07 have been fully considered but they are not persuasive. With regard to Christensen, Applicant contends the pivot disclosed by Christensen is not readable on amended claim 1, specifically "the connector is mounted to the top part of the elongated body only by way of the pair of sensors". Examiner disagrees because figures 9-9b of Christensen show sensors as a portion of the adaptor 250 that connects the connector to the top part of elongated body. In addition, Christenson disclose in paragraph [0057] "The cells 254 can be disposed between the first and second members, or the adaptor 250 and the attachment plate 258 or foot 200." Furthermore, as best understood by the present Application's specification, it is unclear what is meant by "only by way of the pair of sensors" as the specification paragraph [0043] only disclose the sensors located "under" the connector 91 (note the typo, as "91" should read "81").

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3,6,16-19,21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "the connector is mounted to the top part of the elongated body only by way of the pair of sensors".

Figures 10-11 show sensors, or load cells 22A/22B, disposed between the top part and connector, but also appear to show the sensors/rigid plates of figures 5-6 which utilize fasteners to assist connection of the connector to the top of elongated body (see figure 6). In addition, the claim language appear to define the "top part" as the top of the elongated body, i.e plate 83 of figure 10. Therefore, the specification fails to disclose the limitation of a connector mounted to top part of the elongated body only by way of the pair of sensors. In addition, Figure 11 appears to show a connecting aperture similar to those shown in Figure 6, which would allow for another part (not disclosed) to connect the elongated body and connector independent of the sensors, which appear to be only positioned therebetween.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1-3,6,18,19,21 are rejected under 35 U.S.C. 102(e) as being anticipated by Christensen US PUB 2003/012353.

Christensen discloses in figure 9 and paragraphs 53-58 an instrumented prosthetic foot comprising connector 250, elongated body 200 having top and bottom parts, ground engaging areas for heel 246 and toe 238, and a pair of side by side sensors or load cells 254 interfaced with a controller.

Note, the limitation "connector is mounted to the top part of the elongated body only by way of the pair of sensors" of claim 1 is not clearly described in the specification. Applicant's arguments at paragraph 2 of page 11 of the reply filed 8-13-07 state fasteners connecting the top part of the elongated body with the connector is encompassed by the claim limitation. As best understood, the Christensen prosthetic foot such a mount because the pivot 270 is analogous to fasteners described by Applicant.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen US PUB 2003/0120353 as applied to claim 1 above, and further in view of Tarjan et al. US PN 6,091,977.

Christensen meets the structural limitations of claims 16 and 17 but lack the express written disclosure of using a wired or wireless interface to connect the sensor and controller. Tarjan et al. teach control systems for prosthetic parts having sensors wherein the interface may be made by wireless or wired interfaces (c1:10-15 and c5:57-c6:44) in order to transmit data to the controller.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the prosthesis disclosed by Christensen to include a wireless or wired interface as taught by Tarjan et al. in order to transmit data to the controller.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number

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is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/  
Primary Examiner  
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